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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,598

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 25-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 1 July 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/608,598 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

2. Newly submitted claims 25-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The grip of claim 1 can be made of a differ process as forming both layers separately and then using adhesive to secure the layers together.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418).

Pan discloses an antimicrobial grip (abstract) comprising an elastomer (abstract) bonded to a textile layer [0010], an elastomer comprising an inorganic antimicrobial agent in the form of Tin (Sn) (Claim 1) dispersed therein [0009], an elastomer comprising polyurethane in the form of PU ([0009], [0010]), and forming a grip by placing a PU resin into a DMF (dimethyl formamide) solvent and after coating fabric immersing the grip in water ([0010], [0004]).

Pan lacks a grip being an elongated strip, polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape. Huang discloses a grip being an elongated strip (Fig. 5), a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape (Fig. 4). In view of the patent of Huang it would have been obvious to modify the grip of Pan to have a grip

being an elongated strip in order to utilize the advantages of Pan for a grip made from a strip. In view of the patent of Huang (5,695,418) it would have been obvious to modify the grip of Pan to have a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape in order to utilize the advantages of Pan with a grip tape of Huang (5,695,418).

In alternative, Pan lacks PU being polyurethane. Huang discloses PU being polyurethane (Col. 1, Lns. 45-46), forming a grip by placing a dissolved PU solution into DMF (dimethyl formamide) and after coating a fabric immersing the grip in water (Col. 2, Lns. 58-67). In view of the patent of Huang it would have been obvious to modify the grip of Pan to have a PU being a polyurethane in order to utilize a known material used in the art for applying to a fabric which is used for grips.

It appears that the publication of Pan in error defined PU as plutonium instead of polyurethane. The examiner in evaluating the entire publication concluded that this is an obvious error one skilled in the art would recognize. However just to ensure it is clear that PU is considered polyurethane by those skilled in the art the examiner made an alternative rejection. Plutonium normally is abbreviated Pu .

5. Claims 7-8, 16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) as applied to claims 1-6 above, and further in view of Terry.

Pan lacks an antimicrobial metal being silver and a fabric being felt. Terry discloses adding a silver salt to a liquefied polymeric resin prior to molding (Col. 2, Lns. 15-29, Col. 7, Lns. 8-17), producing polyurethane (Col. 6, Lns. 46-50), and using DMF (Col. 11, Lns. 6-13) to produce an antimicrobial composition (Abstract). In view of the patent of Terry it would have been obvious to grip of Pan to have an antimicrobial metal being silver in order to utilize other inorganic materials used in the market place to produce antimicrobial materials. Huang discloses a fabric of felt (Abstract) where polyurethane is coagulated on to (Col. 2, Lns. 58-67) in order to improve the shock absorbing qualities of a grip (Col. 2, Lns. 1-17). In view of the patent of Huang it would have been obvious to modify the grip of Pan to have a fabric being felt in order to improve the shock absorbing qualities of a grip.

6. Claims 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and Terry as applied to claims 7-8, 16, 19 and 22 above, and further in view of Yasui.

Pan lacks an antimicrobial agent silver ion in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent is about 2%. Yasui discloses a urethane material (Col. 2, Lns. 65-67) for a grip (Col. 1, Lns. 21-27) for a fishing pole (fig. 1) having antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-

2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20).

In view of the patent of Yasui it would have been obvious to modify the grip of Pan to have a silver metal in a porous silica-alumina carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order to cause less skin irritation and offer improved durability for an elastomer having an antibacterial agent.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418), Terry and Yasui as applied to claims 9-11 above, and further in view of applicant's disclosure.

Pan lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. The applicant admits a commercially available silica-alumina carrier containing silver is montmorillonite having the formula as defined by claim 12 [0027]. In view of applicant's disclosure it would have been obvious to modify the grip of Huang to have an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12 in order to utilize a silica-alumina carrier containing silver as an antimicrobial agent available in the market place.

8. Claims 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and Terry as applied to claims 16, 19 and 22 above, and further in view of Yasui and applicant's disclosure.

See paragraphs above for elements of structure previously rejected by Pan in view of Yasui and applicant's disclosure.

9. Claims 1-2, 4, 6-11, 13-16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui.

Yeh discloses a grip formed of an elongated strip comprising an elastomer (Col. 2, Lns. 52) layer (12) bonded (Claim 1) to a felt layer (Col. 2, Lns. 54-56), and an elastomer being a thermoplastic urethane (Col. 2, Lns. 51-56), and a polyurethane (Col. 2, Lns. 51).

Yeh lacks an antimicrobial agent silver ion in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent is about 2%. Yasui discloses a urethane elastic material (Col. 2, Lns. 65-67) for a grip (Col. 1, Lns. 21-27) for a fishing pole (fig. 1) having antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20). In view of the patent of Yasui it would have been obvious to modify the grip of Yeh to have a thermoplastic urethane layer or a polyurethane layer comprising silver metal in a porous silica-alumina carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order to cause less skin irritation and offer improved durability for an elastomer having an antibacterial agent.

10. Claims 12, 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui as applied to claims 1-2, 4, 6-11, 13-16, 19 and 22 above, and further in view of applicant's disclosure.

Yeh lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. The applicant admits a commercially available silica-alumina carrier containing silver is montmorillonite having the formula as defined by claim 12 [0027]. In view of applicant's disclosure it would have been obvious to modify the grip of Yeh to have an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12 in order to utilize a silica-alumina carrier containing silver as an antimicrobial agent available in the market place.

Response to Arguments

11. The examiner maintains the argument that plutonium has the symbol Pu and it is well known in the market place to define polyurethane as PU and an error was made in the publication of Pan. In Pan PU is defined as plutonium instead of polyurethane. Due to this application being from a foreign inventor this could easily have been a translation error. Looking at the application as a whole everything would point to PU as being a polyurethane. The examiner in evaluating the entire publication concluded that this is an obvious error one skilled in the art would recognize. The argument that Pan discloses an organic antimicrobial agent in the form of organtin is disagreed with. The applicant's application clearly calls tin an inorganic antimicrobial agent (Claim 6).

Clearly Pan discloses tin (Claim 1). Therefore Pan has an inorganic antimicrobial agent as defined by the applicant. In addition, an organic is something from a living tissue from a plant or animal. Clearly tin is not from a plant or animal. The argument that it is improper to use the combination of Yasui and Pan due to Yasui and Pan using different processes is disagreed with. Both are directed to a method of molding and both are adding additives to the molding process.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burrell discloses silver and tin antimicrobial metal containing materials [0045] for polyurethanes [0082]. Wagner discloses examples of metals as tin and zinc (Col. 11, Lns. 59-65) used to produce polyurethane (Title) using DMF (Col. 22, Lns. 50-60). Hagiwara discloses polymers formed with salt of a metal (abstract) such as silver zinc and tin (Col. 3, Lns. 23-32).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3700. (TC 3700 Official Fax 571-273-8300)

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slb/ 18 August 2005



STEPHEN BLAU
PRIMARY EXAMINER